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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 08/729,341 | 10/16/1996 | OPHIRA R. AHARONSON | | 3864 |

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EXAMINER

WU, XIAO MIN

ART UNIT PAPER NUMBER

2629

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 08/729,341 | Applicant(s) AHARONSON ET AL. | |
| | Examiner XIAO M. WU | Art Unit 2629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,20-42,57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,20-42,57 and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The reply filed on November 4, 2004 has been entered and considered by examiner.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-11, 20-42 and 57-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 32 copied from Cotte's reference (U.S. Patent No. 5,499,108) recite "wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data". However, there is no description in the specification to support the feature of the placement alone is sufficient to initiate said drawing nor means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data. The closest disclosure in the specification is as follows:

(a) Figure 1 of the application shows a monitor (H2), but does not disclose the feature of " means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

(b) On page 18, lines 14-18 of the specification discloses a master mode which the scanner automatically starts scanning, but does not discloses the limitations "means for displaying, in response to said replacement, a plurality of user-selectable options for processing said image data".

(c) On page 22, last line to page 23, line 2, discloses that "the user may choose to use a scanner for data input by picking operation from a menu or typing a specification", but does not disclose the feature " means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data". For example, the specification does not disclose a menu displayed on the screen. The menu mentioned in the specification may be placed on the keyboard before replacement. Even the menu of the specification is displayed on the monitor, but the specification does not disclose the limitation "means for displaying, in response replacement..."

No where in the specification discloses the limitation "means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

Dependent claims 8-9 and 23-24 recite the limitations ""scanning means sends an interrupt to said computer in response to said replacement" and ""said image data periodically polls said input device". However, nowhere in the specification discloses such limitation above. Page 18, lines 14-18 of the specification describes a master mode with the host receives the

scanned data into "spool" directory where it is stored for application to retrieve it, but does not mention the limitations "interrupt" nor "periodically polls" as recited in the claims.

Independent claims 20 and 26 recite the limitation " a plurality of user selectable options for processing said image data wherein said placement alone is sufficient to initiate display of said options". Again, nowhere in the specification discloses this limitation for the same reason as addressed in claim 1.

Independent claim 57 has similar problem as previously discussed on the independent claims 1, 20, 26 and 32 above. No where in the specification discloses "wherein said inserting is sufficient to initiate said drawing, and said computer comprising means for displaying the scan image data and means operable in response to said inserting of the document for initiating communications protocol with the computer for a plurality of user-selectable options for processing said image data" as recited in claim 57. It is noted that claims 57-58 recite the same limitation as claims 1-2 as stated by applicant on page 10 of the Remarks filed on February 11, 2004. That is "newly presented claims 57 and 58 precisely track claims 1 and 2".

The remaining claims 2-11, 21-25, 27-31 and 33-42, 58 are rejected to as being dependent upon a rejected base claims.

In view of lacking written description, no art rejection has been applied since the specification does not support the limitations recited in the claims 1-11 and 20-42.

Response to Arguments

4. Applicant's arguments filed November 4, 2004 have been fully considered but they are not persuasive.

On page 3 of the Reply, applicant argues that the examiner appears not to appreciate that the original specification, in its introduction, moreover, identifies and thus incorporates by reference specific types of then current computer ("IBM PC", Apple 105", etc.). all with their then well-known "plurality of user-selectable options" for processing scanned images as referenced and described in the Rodriguez declaration. These argument is not persuasive because the claim requires "means for displaying, in response to said placement, a plurality of user-selectable options for processing said image", and not just simply displaying a plurality of user-selectable options. The plurality of the user-selectable options are displayed in condition of detecting the placement of the document into the scanning. If these features are well known in the art, applicant needs to provide such evident.

On page 4 of the Reply, applicant argues that there are two responses, not just one response to "placement" technically required for display:

(1) there must be, as the claim recites, "displaying" of the scanned image data, which requires a first or initial "response to said placement", or else there is no scanning done and no image data for the computer to display; but

(2) there must be, also , a second response coming from the claim's further recitation of "user-selectable options" to effect the display.

Applicant concludes that "the plurality of user selected options" [the second response needed (by the user, not the placement) and claimed as required by user selection--] for ultimate processing of said image data. These arguments are not persuasive. First, there is no two responses as recited in claim. Claim 1 does not require to display scanned image in response to the placement and claim 1 also does not required the user to select the options in order to display

the image data. Claim 1 only requires one response such as placement of the document into scanning for displaying a plurality of user-selectable options.

With respect to applicant's own words, applicant fails to point out that the user-selectable options are displayed in response to the placement. The closest part in the specification as applicant pointed out is "a slave output device for display communication and printing". However, this portion of the specification is insufficient to support the limitation of "means for displaying, in response to said placement, a plurality of user-selectable options for processing said image" as required in claims.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to XIAO M. WU whose telephone number is 571-272-7761. The examiner can normally be reached on 6:30 am to 4:00 pm.

Art Unit: 2629

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD HJERPE, can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

X.W.
June 11, 2006


XIAO M. WU
Primary Examiner
Art Unit 2629